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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,539	08/27/2001	Stephane Fouquay	58779.000017	2787

7590 06/23/2005

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/938,539

Applicant(s)

FOUQUAY ET AL.

Examiner

Thao T. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to the Amendments filed 3/15/2005.
2. Claims 1-22 are currently pending in this application. Claims 12 and 14-28 have been withdrawn as directed to a non-elected invention, as indicated in the Paper of 2/5/2005.

### ***Claim Rejections - 35 USC § 103***

3. Claims 1-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lallier et al. (US Pat. 6,001,192) in view of Mitsuhashi et al. (US Pat. 5,599,954).

Lallier teaches a composition and a method of making, the composition comprising an aprotic polar solvent (TPA), an ether (TE), and an activator (TA) (see col. 1, ln. 40-52; col. 2, ln. 40). Lallier further teaches the solvent being dimethyl sulfoxide or dimethyl formamide, the ether being dioxolane or methoxytetrahydrofuran, having a molar volume of less than 160 having several methoxy groups (see col. 2, ln. 12-20).

In regards to claims 1-5 and 13, Lallier, however, differs from the presently claimed invention because Lallier does not teach a specific activator as recited in the instant claims.

Mitsuhashi teaches a composition comprising a mixture of ethers comprising tetrahydrofuran and acetonitrile, and a mixture of activators comprising imidazole (see col. 6, ln. 59-65).

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have employed the activators, as taught by Mitsuhashi, in the composition of Lallier, because the use of an ether activator, such as imidazole, would have activated the reaction forward and would have resulted in better yield of the product.

With respect to the use of the composition for surface treatment of polyester resin, it has been held that recitation on intended use would have no significant patentable weight.

In regards to claims 6-8, Lallier further teaches the aprotic polar solvent and the ether are present in a volume ratio of 50/50 (see col. 2, ln. 10).

In regards to claims 9, Lallier teaches the ether having a flash point higher than 0oC (see col. 1, ln. 47), and not specifically higher than 100oC. However, since Lallier teaches the same ether in the same composition, the flashing point of Lallier would inherently be the same as that of the instant invention.

In regards to claims 10-11, Lallier teaches the ether to be dimethoxybenzene (see col. 2, ln. 14-16).

### ***Response to Arguments***

4. Applicant's arguments filed 3/15/2005 have been fully considered but they are not persuasive.

5. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

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generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mitsuhashi is used to illustrate that imidazole has been used as an ester activator in the prior art, and thus can be used to remedy Lallier.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. With respect to the arguments that claims 7-8 recite the voluminal ratio of the polar aprotic solvents with respect to each other and not the ratio of the aprotic solvent to the ether, the examiner agrees that this was an inadvertent error. However, as disclosed by Lallier, the aprotic solvents are used as mixtures, and given the amounts of the solvents and the ether provided in Lallier, it appears that the ratios recited in the instant claims would fall into the range.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

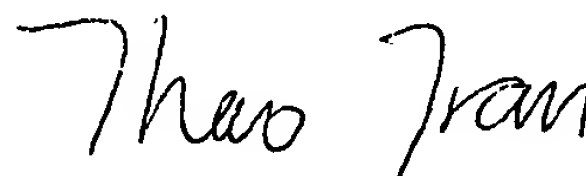
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 571-272-1080. The examiner can normally be reached on Monday-Friday, from 9:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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June 20, 2005



**THAO T. TRAN  
PATENT EXAMINER**